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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,883	04/12/2004	Russell A. Firestone III	36707-501	2490
64046 7590 08/10/2009 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER CONLEY, SEAN EVERETT				
ART UNIT 1797		PAPER NUMBER		
MAIL DATE 08/10/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/821,883

**Applicant(s)**

FIRESTONE ET AL.

**Examiner**

SEAN E. CONLEY

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed May 19, 2009 has been received and considered for examination. Claims 1-22 remain pending.

### ***Claim Objections***

2. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Specifically, amended claim 1 includes the limitations of claim 2 and thus claim 2 fails to further limit claim 1.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-17, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldner et al. (U.S. Patent No. 5,270,000) in view of Nealy-Brown (article titled "Paper Shredding Business Piles Up").

Goldner et al. discloses an apparatus and process for treating medical wastes (2) such as bandages, syringes, and wastes produced daily from hospitals (see col. 1, lines 5-16). The process comprises the step of first shredding the waste (2) in loading chamber (3) using a refuse comminutor (7) (see col. 4, lines 18-39). The loading chamber (3) is heated with conductive heat from a heating circuit so that the wastes may be preheated (see col. 10, lines 18-38). After the wastes are ground up they are sent to the treatment section which comprises a microwave chamber (16) and a temperature maintenance chamber (17). Prior to entering the microwave chamber the waste is sprayed with water in transfer tunnel (18) to moisten the waste prior to microwave treatment (see col. 4, lines 40-53). The moistened waste is then treated with microwaves in the microwave chamber (16) to heat the waste (see col. 5, lines 7-38). After heating by microwaves the waste is transferred to the temperature maintenance chamber where it is held for a predetermined period of time and at a minimum temperature sufficient to ensure complete disinfection (see col. 6, line 47 to col. 7, line 6; see col. 8, lines 32-49). The process results in medical waste that has been shredded and disinfected with all pathogenic germs eliminated.

Goldner et al. fails to explicitly identify medical records as an item of medical waste that is treated in the process.

Nealy-Brown discloses in the article that shredding documents protects people's privacy. Types of documents that are shredded include documents with social security numbers, Medicaid numbers, employee information, and medical records. Furthermore, government regulations have helped the document destruction industry by requiring

hospitals, doctors, pharmacies, and insurance companies to protect patient's medical records (by destroying them via shredding). (See entire article). It is well known that medical records include patient personal information such as protected health information, demographic information, addresses, dates of treatment, etc.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Goldner et al. to include the shredding of medical records in combination with the process of shredding medical wastes in the device disclosed by Goldner et al. since Nealy-Brown discloses that it is well known to shred medical records to protect patient privacy. Furthermore, it would have been obvious to combine the process of shredding medical records with the process of shredding medical waste since such a combination would yield the predictable result of a more efficient removal of waste and documents from a hospital or doctors office using a single machine and a single process.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldner et al. in view of Nealy-Brown as applied to claim 15 above, and further in view of Dineley et al. (U.S. Patent No. 5,209,411 ).

The combination of Goldner et al. and Nealy-Brown is set forth above. However, the combination of Goldner et al. and Nealy-Brown does not teach the step of subjecting the waste or documents to X-rays or ultraviolet light.

Dineley et al. disclose a process of shredding medical waste disposed from hospitals and other medical treatment facilities. The process comprises first

comminuting the medical waste and then transferring the waste to a decontamination chamber where the waste is exposed to ultraviolet radiation alone or in combination with other treatments (see col. 1, lines 10-23; see col. 2, lines 1-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Goldner et al. to include an additional step of exposing the medical waste and documents to ultraviolet radiation as exemplified by Dineley et al. to yield the predictable result of further enhancing the overall disinfection and decontamination of the medical waste and documents by following one treatment (microwave exposure) with another (ultraviolet radiation) which produces a synergistic disinfection.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldner et al. in view of Nealy-Brown as applied to claim 15 above, and further in view of Mosenson et al. (U.S. Patent No. 6,494,391 B2) and Noda (JP 6320057 A – English abstract).

The combination of Goldner et al. and Nealy-Brown is set forth above. However, the combination of Goldner et al. and Nealy-Brown does not teach the step of subjecting the waste or documents to ozone, wherein the ozone is generated from an electrode inserted into a chamber including the documents.

Mosenson et al. teaches an apparatus and process for treating medical wastes. The process includes first shredding the medical waste and then exposing the shredded

waste to gaseous ozone in order to disinfect the waste (see col. 1, lines 45-67; see col. 4, lines 21-30; see col. 5, line 49 to col. 6, line 35).

Noda discloses a process of disinfecting items in a sterilization tank (25) wherein an electrode device (27) is provided in the sterilization tank to generate ozone which sterilizes the items (see English abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Goldner et al. to include an additional step of exposing the medical waste and documents to gaseous ozone as exemplified by Mosenson et al. using an ozone generating electrode as exemplified by Noda, in order to yield the predictable result of further enhancing the overall disinfection and decontamination of the medical waste and documents by following one treatment (microwave exposure) with another (gaseous ozone) which produces a synergistic disinfection of the wastes.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldner et al. in view of Nealy-Brown as applied to claim 1 above, and further in view of Orlando (U.S. Patent No. 5,186,397).

The combination of Goldner et al. and Nealy-Brown is set forth above. However, the combination of Goldner et al. and Nealy-Brown does not teach the step of compacting the shredded waste and documents after treatment.

Orlando discloses a method and device for disposal of medical waste. The process comprises shredding the medical waste after it has been sterilized in an

autoclave. The process includes the additional step of compacting the medical waste in using piston (21) located below the shredding apparatus (13). The compact medical waste is held in storage area (2) where it is further compacted prior to eventual disposal (see figure 1; see col. 5, lines 22- 41; see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process and invention of Goldner et al. and include a storage area with a means for and process step for compacting the shredded waste and documents after treatment as exemplified by Orlando in order to enable the mobile device of Goldner et al. to process additional amounts of medical waste with fewer trips to a landfill or dump site.

### ***Response to Arguments***

8. Applicant's arguments filed May 19, 2009 have been fully considered but they are not persuasive.

The applicant first argues the following: *"nowhere does Nealy-Brown suggest or disclose that documents including protected health information can be shredded with medical waste, much less a mechanism having little or no liquid effluent and little or no toxic air emissions. Indeed, Nealy-Brown teaches away from claim 1 by suggesting the use of traditional document shredding (see, e.g., Nealy- Brown, page 2 of 2, second paragraph) that merely shreds paper without processing the medical waste (e.g., processing by using heat, ozone, etc.) to yield little or no liquid effluent and little or no toxic air emissions.*



*In view of the foregoing, neither Goldner nor Nealy-Brown suggests or discloses at least the following feature of claim 1: "supplying the documents including protected health information to an apparatus adapted to shred documents and medical waste, the apparatus having little or no liquid effluent and little or no toxic air emissions." Therefore, claim 1 and claims 2-17, 20, and 22, at least by reason of their dependency from independent claim 1, are allowable over Goldner and Nealy-Brown, whether those references are taken alone or in combination, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn."*

The Examiner respectfully disagrees. Goldner has been relied upon to teach that it is well known to shred medical waste in an apparatus having little or no liquid effluent and little or no toxic air emissions. As stated by the applicant, the rejection relies upon Nealy-Brown to teach that it is well known to shred medical documents and records using conventional shredders. Nealy-Brown does not teach away from claim 1 as asserted by the applicant, but in fact teaches that any type of shredder can be used to shred the medical documents/records. Therefore, it would have been obvious to one of ordinary skill in the art to utilize the shredder disclosed by Goldner to also shred medical documents and records to provide the predictable result of a more efficient removal of waste and documents from a hospital setting using a single apparatus and a single shredding process. Claims 1-17, 20, and 22 remain rejected as being unpatentable over Goldner in view of Nealy-Brown.

Concerning claim 19, the applicant argues that Mosenson fails to disclose the new limitation of an ozone electrode inserted into the chamber. The newly cited art to

Noda teaches an ozone generating electrode that is inserted directly into the sterilization chamber to generate ozone (see rejection above). Claim 19 remains rejected for at least the reasons stated above.

Claims 18 and 21 also remain rejected as stated in the previous office action.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E. Conley whose telephone number is 571-272-8414. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 4, 2009

/Sean E Conley/  
Primary Examiner, Art Unit 1797